

### REMARKS

Claims 1-11 are pending in the present application. Claims 1 and 7 have been amended without prejudice, Claims 4-6 and 8-11 have been cancelled without prejudice, and Claims 12-19 have been added, leaving Claims 1-3, 7, and 12-19 for consideration upon entry of the present Amendment. The Specification has been amended to correct typographical errors. No new matter has been introduced by any of the amendments made to the Specification and to the Claims, as support for the amendments is found in the Specification, Drawings, and Claims as originally filed. Reconsideration and allowance of the claims is respectfully requested in view of the above amendments and the following remarks.

#### Claim Rejections Under 35 U.S.C. § 102(b)

Claims 1, 4-6, and 10 stand rejected under 35 U.S.C. § 102(b) as allegedly anticipated by U.S. Patent No. 5,746,567 to Herbermann et al. ("Herbermann"). More particularly, the Examiner states:

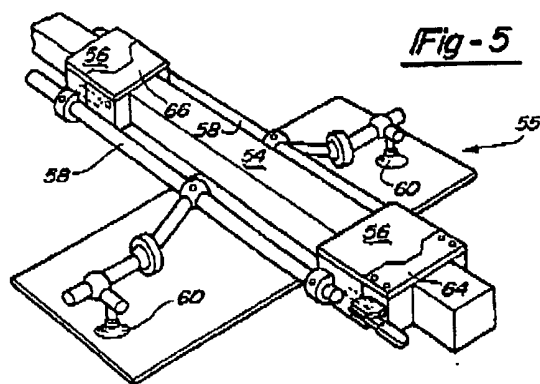
Herbermann et al. teaches a linear adjustment device/system comprising a positioning mechanism (figure 5) including a rod (58), a first pipe (adjacent to element 56 at the left side) slidably engaged with the rod and a second pipe (adjacent to element 56 at the right side) slidably engaged with the rod. The mechanism includes a load sleeve (56 at the left side), wherein the load sleeve is secured to the first pipe and an anchor sleeve (56 at the right side) wherein the anchor sleeve is secured to the second pipe. The system includes a main structural element (54). The load sleeve and the anchor sleeve are disposed on the main structural member. The system includes a fastening means (64) for securing the anchor sleeve to the main structural member. The system further includes a fastening means (64) for securing the anchor sleeve to the main structural member. The system further comprises a second linear adjustment device comprising a positioning mechanism (located on the other side element 54 in figure 5) comprising rod, first and second pipes, load sleeve and anchor sleeve.

Claims 4-6 and 10 have been cancelled without prejudice, thereby making the Examiner's rejection of these claims moot. Applicant respectfully traverses the rejection of Claim 1.

To anticipate a claim under 35 U.S.C. § 102(b), a reference must disclose each and every element of the claim. *Lewmar Marine v. Varient, Inc.*, 3 U.S.P.Q.2d 1766 (Fed. Cir. 1987). Claim 1 sets forth in part "a load sleeve, wherein the load sleeve is

secured to the first pipe and further wherein the load sleeve is configured to hold the load." Accordingly, to anticipate Claim 1, Herbermann must, at the very least, teach or suggest a load sleeve adapted to hold a load. It is noted that the load to be held by the load sleeve is distinguishable from the first pipe and from the rod of the positioning mechanism set forth in Claim 1.

Referring to Figure 5, which for convenience is reproduced below, Herbermann teaches two saddle brackets 56 supported by a boom 54. Disposed on each lateral side of brackets 56 is a structure through which a cylindrical member 58 extends. A tool 60, which is attached to each cylindrical member 58 holds a workpiece.



Therefore, unlike Claim 1, which states that the load sleeve holds a load, the saddle brackets 56 taught in Herbermann do not hold a load as is contemplated by Claim 1; rather, it is the tools 60, which are attached to cylindrical members 58, that hold a workpiece load. Additionally, it cannot be argued that the saddle brackets 56 of Herbermann hold boom 54 as the term "hold" is contemplated by Claim 1. Rather, the saddle brackets 56 are merely supported by boom 54. Therefore, as Herbermann fails, at the very least, to teach or suggest a load sleeve configured to hold a load, it cannot anticipate Claim 1. Accordingly, Applicant respectfully requests reconsideration and withdrawal of this rejection.

Claim Rejections Under 35 U.S.C. § 103(a)

Claims 2, 8, and 11 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Herbermann. More particularly, the Examiner states that Herbermann fails to teach the first pipe and second pipe connected to the rod by a first securing element and a second securing element. However, the Examiner states, Figure 1a in Herbermann depicts a clamp having the securing element (31b) mounted on the rod. The Examiner argues that it would have been obvious to have used the securing element to the first and second pipes to prevent the rod from sliding in and out of the first and second pipes. Claims 8 and 11 have been cancelled without prejudice thereby making the Examiner's rejection of these claims moot. Applicant respectfully traverses the rejection of Claim 2.

For an obviousness rejection to be proper, the Examiner must meet the burden of establishing a prima facie case of obviousness. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). Establishing a prima facie case of obviousness requires that all elements of the invention be disclosed in the prior art. *In re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A 1970). Claim 2 depends from Claim 1, and therefore includes all of the limitations of Claim 1. Accordingly, to establish a prima facie case of obviousness against Claim 2, Herbermann must, at the very least, teach all of the claimed elements of Claim 1.

As previously discussed above, Herbermann fails to teach or suggest a load sleeve configured to hold a load. Herbermann, therefore, does not teach or suggest all of the elements of Claim 1, and hence, of Claim 2. Accordingly, a prima facie case of obviousness has not been established for Claim 2. Applicant, therefore, respectfully requests reconsideration and withdrawal of this rejection.

Claims 3 and 9 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Herbermann in view of U.S. Patent No. 5,251,993 to Sigourney ("Sigourney"). More particularly, the Examiner states that although Herbermann fails to teach the first securing element comprising a first nut disposed adjacent to a first terminal end of the first pipe and a second nut disposed adjacent to a second terminal end of the first pipe and

the second securing element comprises a first nut disposed adjacent to a first terminal end of the second pipe and a second nut disposed adjacent to a second terminal end of the second pipe, Sigourney teaches the first securing element comprising a first nut (35) a second nut (36) and the second securing element comprising a first nut (45) and a second nut(46). The Examiner states that it would have been obvious to have modified Herbermann's first and second securing elements with the first and second nuts as taught by Sigourney to provide an alternative method for securing the rod on the first and second pipes. Claim 9 has been cancelled without prejudice thereby making this claim rejection moot. Applicant respectfully traverses the rejection of Claim 3.

As previously stated, establishing a prima facie case of obviousness requires that all elements of the invention be disclosed in the prior art. *In re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A 1970). Claim 3 depends from Claim 1, and therefore includes all of the limitations of Claim 1. Accordingly, to establish a prima facie case of obviousness against Claim 3, Herbermann and Sigourney, either alone or in combination, must, at the very least, teach all of the claimed elements of Claim 1.

As previously discussed above, Herbermann fails to teach or suggest a load sleeve configured to hold a load. Herbermann, therefore, does not teach or suggest all of the elements of Claim 1, and hence, of Claim 3. Neither does the Examiner assert that Sigourney cures this deficiency. As neither Herbermann nor Sigourney, either alone or in combination, teach or suggest all of the elements of Claim 3, a prima facie case of obviousness has not been established for Claim 3. Applicant, therefore, respectfully requests reconsideration and withdrawal of this rejection.

#### **Allowable Subject Matter**

Applicant respectfully acknowledges the Examiner's statement that Claim 7 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Accordingly, Applicant has amended Claim 7 without prejudice pursuant to the Examiner's recommendation. Applicant requests reconsideration and allowance of Claim 7.

In light of the foregoing amendments and remarks, reconsideration by the Examiner is respectfully requested. It is believed that the foregoing amendments and remarks fully comply with the Office Action and that the claims herein should stand allowable.

Respectfully submitted,

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